

**THIS DISPOSITION IS NOT
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OF THE TTAB**

Mailed:
June 23, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stancil Corporation

Serial No. 78114064

Guy W. Churchouse for Stancil Corporation.

John Dwyer, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Hairston, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Stancil Corporation seeks registration on the
Principal Register of the mark TEN - 4 for goods identified
in the application as "computer software for voice
recording purposes" in International Class 9.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this designation based upon Section 2(d) of the
Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining
Attorney has taken the position that applicant's mark, when

¹ Application Serial No. 78114064 was filed on March 11, 2002
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce.

used in connection with the identified goods, so resembles the mark TENFOUR registered for goods identified as follows:

computer software, computer diskettes, and CD-ROM's, all for monitoring electronic messaging, providing interconnectivity between electronic messaging systems, platforms, and networks; regulating electronic messaging information flow, and for providing addressing, encryption, translation, and virus scanning for electronic messaging systems, and instruction manuals related thereto, in International Class 9

telecommunications services, namely, electronic mail services, and electronic store-and-forward messaging, in International Class 38; and

software consulting services and technical consultation in the field of computer engineering, in International Class 42.²

as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request an oral hearing before the Board.

We reverse the refusal to register.

In arguing for registrability, applicant contends that "electronic messaging" is quite separate and distinct from "voice recording." By contrast, the Trademark Examining Attorney argues that applicant's software is related to

² Registration No. 2158276 issued on May 19, 1998.

registrant's software and can be used in conjunction with registrant's goods and services.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

As we turn first to the du Pont factor focusing on the similarity of the marks, there is no dispute but that the marks are quite similar as to appearance, sound and meaning. Whether presented as numerals or words, the connotation remains the same.³ When spoken, the sound of both marks is identical. While the marks are somewhat different in appearance, this slight difference is not sufficient to create a significant legal distinction

³ We take judicial notice of the most popular connotation of this term drawn from the "ten code" employed for decades by users of Citizens Band radios: "**Ten-four** *CB Radio Slang*. (Used to express affirmation or confirmation) Cf. **ten code** [1960 -1965]" The Random House Dictionary of the English Language (Second Edition, Unabridged 1987) p. 1956; "**ten-four** exclamation (also 10-4) *MAINLY US* said to mean that a message has been received,"

between the marks as to their overall commercial impressions. Hence, the decision of likelihood of confusion in this case turns on the relationship of the goods and services.

The Trademark Examining Attorney placed pages from applicant's website into the record. That information includes details about the involved digital recording product directed to the public safety sector, commercial contact centers and financial institutions:

Welcome to the Stancil Product line-up

Stancil started voice logging and from day one we focused on the 24 X 7 Public Safety, Military and Security environments.

This focus has now reached across seven decades and our mission has not changed - using the latest technologies to perform the functions these intense applications require.

Our **TEN-4** recorder was designed from the ground up to address these requirements. We listened to you and did it your way with relentless dedication to address your specific needs.

Stancil's **voiceXP** Series **TEN-4** recorder has an array of industry firsts:

- Windows 2000 or XP Operating System
- .NET distributed component architecture
- XML Backup
- SQL Server MSDE Engine
- Streaming Audio Plus Checking a Call in Progress
- Message Queuing Connectivity

The use of the latest PC Technologies allows us to add new functionality and enhance our traditionally excellent operational features:

- Unlimited Simultaneous Multi Channel Real Time Playback
- Scenario Reconstruction
- **TEN-Zoom** - view from 24 hours to one minute
- **TEN-9** Two Channel Repeat - True Instant Recall⁴

Cambridge Advanced Learner's Dictionary,
<http://www.dictionary.cambridge.org>

⁴ http://www.stancilcorp.com/new_products.htm

and



The most advanced multi-channel digital voice recorder on the market today.

Digital Voice Recorders from Stancil Corp.

The **TEN-4** Digital Voice Logger is the world's first voice logger based on Microsoft's .NET framework.

TEN-4 features include:

- Off Hook Voltage Sense recording
- VOX recording
- Continuous recording
- Record On Demand
- Distributed storage
- DVD-Ram
- Hard drive or RAID 1 or 5 Online Storage

Playback features include:

- Customizable and secure user authentication
- Tabular call detail view and playback
- Multi-channel view - the multi-channel simultaneous play View that can be used to play multiple channels at the same time and/or display calls highlighted in the Tabular View for scenario or tactical analysis
- Spoken Time - provides a spoken time announcement of the date and time of a call prior to playback
- Detailed searching
- Call tagging - A call or group of calls can be tagged whilst in progress or at a later time
- Playback looping
- Fast forward, Rewind, Next and Previous Call controls for fast navigation
- Time based zoom control for detailed analysis
- Master volume control
- Channel volume controls - set the playback volume on an individual channel
- Speaker selection - select which speaker each channel plays back on⁵

⁵ http://www.stancilcorp.com/new_features.htm

As to registrant's goods and services, we agree with applicant that registrant's software and services, as identified, pertain exclusively to "electronic messaging," and the identification of goods and the recital of services point to a company whose software solutions provide secure email gateways for businesses, relying on servers capable of filtering, virus protection, translation, encryption, decryption, etc. Registrant's "store and forwarding" services (International Class 38) are inextricably tied into email transmissions, and its software consulting services (International Class 42) are related generally to "computer engineering."

Yet the Trademark Examining Attorney argues that the definition of "messaging" includes "voice mail":

By definition, the registrant's electronic messaging services involve the conveying of "voice mail," and voice mail involves the recording of telephone messages. The applicant's voice recording software as identified in the application is not limited to a specific field, nor to specific purchasers, nor to a specific channel of trade. Therefore, the examining attorney must presume that the applicant's voice recording software can be used in recording telephone voice mail messages for electronic messaging, and in recording telephone voice messages in connection with store-and-forward messaging services. [citation omitted].

(Trademark Examining Attorney's appeal brief, p. 7)

However, the Trademark Examining Attorney has not established that registrant's repeated use of "electronic messaging" should be read so loosely that it includes the recordation of voice mail messages. Moreover, we find no evidence in this record that email software is related in any way (e.g., commercially, technologically, by channels of trade, etc.) to voice messaging software.

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, it is clear from applicant's webpages placed into the record by the Trademark Examining Attorney that these multi-channel recorders are expensive and high-technology products being selected by careful and sophisticated purchasers. This helps to reduce the likelihood of confusion.

In conclusion, in spite of the fact that these respective marks create similar overall commercial impressions, we find that the Trademark Examining Attorney has not demonstrated that applicant's voice recorders are related to registrant's secure email products and collateral services, such that prospective purchasers would be confused as to the source of the respective goods and services. Hence, on this record, we do not find a likelihood of confusion, and this application will proceed

to publication in the Trademark Official Gazette. We acknowledge that should a different record be created within an *inter partes* proceeding, a different result might well ensue.

Decision: The refusal to register based upon Section 2(d) of the Trademark Act is hereby reversed.